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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/747,506	12/22/2000	Jared Schutz Polis	Schutz-P1-00	8671
7590		09/20/2007		
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			EXAMINER	
			HEWITT II, CALVIN L	
			ART UNIT	PAPER NUMBER
			3621	
			MAIL DATE	DELIVERY MODE
			09/20/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

09/747,506

Applicant(s)

POLIS, JARED SCHUTZ

Examiner

Calvin L. Hewitt II

Art Unit

3621

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 05 September 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-21 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-21 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

Status of Claims

1. In view of the Appeal Brief filed on 06 September 2006, PROSECUTION IS HEREBY REOPENED. A new ground of rejection is set forth below.
2. Claims 1-21 have been examined.

Response to Arguments

3. In light of Applicant's interpretation of claim 1 and other newly presented arguments the Examiner has reopened prosecution.

Claim 1 recites "providing a first website have identifier data" and "encrypting the identifier data". According to Applicant this language is equivalent to "providing a website having identifier data that is encrypted" (Appeal Brief, 9-5-06, page 33, section b, i, line 9). A *website* is defined as a group of related HTML documents and associated files, scripts and databases that is served up by an HTTP server on the World Wide Web". *Hypertext* is a text linked together in a complex, nonsequential web of associations in which a user can browse through related topics. *HTML* is "a markup language used for documents on the World Wide Web". *HTML* is also "an application of SGML that uses tags to mark elements, such as text and graphics, in a document to indicate how Web

browsers should display these elements to the user and should respond to the user actions". And, an *HTML document* is a hypertext document that has been encoded with HTML (emphasis added) (Microsoft Press Computer Dictionary, Third Edition, 1997). Therefore, given the following definitions (with attention to the emphasized portions), one of ordinary skill understands that a website is intended to be viewed by a user. Hence, "providing a website having identifier data that is encrypted" implies that the encrypted identifier is either displayed or at least viewable to a user at a website. Applicant's Specification, however, is silent such a recitation. More specifically, Applicant discloses entering a (clear text) credit card number and expiration date (Specification, page/line 18/15-19/11; page 22, lines 1-12; page 24, lines 5-15), passing encrypted payment information (although it is unclear what this encrypted payment information is) (Specification- filed 1-15-02, page 20, line 5) or an encrypted card number using SSL (Specification- filed 1-15-02, page/line 27/23-28/1; page 33, lines 4-6), and displaying a gift certificate linked to a Visa debit card wherein the Visa debit card number is encrypted using a "private key" (Specification- filed 1-15-02, page/line 21/22-22/13). None of these instances support a website "having identifier data that is encrypted".

Applicant also recites (Specification- filed 12-22-00, page/line 11/27-12/2),

By using the URL as, or as part of, the data of the browser with data 12, identifier payment data is included that encapsulates the information entered in first web site 10 and/or site 38, some of which is encrypted, e.g. private-private key encrypted, for which keys are held by both the greeting card company and the provider of the information

However, this statement is vague as it is unclear what is encrypted using the private-private key encryption. On the other hand, Applicant's teaches using private-private key encryption to encrypt a visa debit card number (Specification- filed 1-15-02, figure 5, item 2 "IF STORE SITE PASS..."; page 21, lines 9-12). And, while Applicant discloses an encoded url (Specification- filed 1-15-02, page 21, lines 20-22) the Specification is silent regarding when the url is encoded, if the encoded url is displayed to the user, and appears to contradict Applicant's prior statement of using the url to pass to a merchant an encoded visa debit card number (Specification- filed 1-15-02, page 21, lines 8-11) as opposed to encrypting the url. Therefore, Applicant's Specification does not support "providing a website having identifier data that is encrypted" which according to Applicant is equivalent to "providing a first website have identifier data" and "encrypting the identifier data" (Appeal Brief, 9-5-06, page 33, section b, i, line 9).

Applicant also does not have support for equating the identifier of claim 1 with a GUID or UUID (Appeal Brief, dated, 9-5-06, page 32, lines 3-25).

Claim Rejections - 35 USC § 112

4. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

5. Claims 1 and 7-20 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Claim 1 recites "providing a first website have identifier data" and "encrypting the identifier data". According to Applicant this language is equivalent to "providing a website having identifier data that is encrypted" (Appeal Brief, 9-5-06, page 33, section b, i, line 9). However, the Specification does not support such an interpretation as Applicant only discloses: entering a (clear text) credit card number and expiration date (Specification, page/line 18/15-19/11; page 22, lines 1-12; page 24, lines 5-15), passing encrypted payment information (although it is unclear what this encrypted payment information is) (Specification- filed 1-15-02, page 20, line 5) or an encrypted card number using SSL (Specification- filed 1-15-02, page/line 27/23-28/1; page 33, lines 4-6), and displaying a gift certificate linked to a Visa debit card wherein the Visa debit card

number is encrypted using a "private key" (Specification- filed 1-15-02, page/line 21/22-22/13). Applicant also recites (Specification- filed 12-22-00, page/line 11/27-12/2),

By using the URL as, or as part of, the data of the browser with data 12, identifier payment data is included that encapsulates the information entered in first web site 10 and/or site 38, some of which is encrypted, e.g. private-private key encrypted, for which keys are held by both the greeting card company and the provider of the information

However, this statement is vague as it is unclear what is encrypted using private-private-key encryption.

Applicant also does not have support for equating the identifier of claim 1 with a GUID or UUID (Appeal Brief, dated, 9-5-06, page 32, lines 3-25).

Claims 7-20 are also rejected as each depends from claim 1.

6. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

7. Claims 8-14, 19 and 20 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 8 and 9 recite a gift as a financial transaction. Similarly, claims 10-14 recite a coupon, a rebate, conveying money, cash surrogates and a stored-value vehicle, respectively, as a financial transaction. However, these items are things, or more accurately the output of a transaction, and not the transaction

itself. A transaction is defined as a "business deal" (Webster's Ninth New Collegiate Dictionary). Therefore, one of ordinary skill understands a transaction as goods and services exchanged for other goods and services (i.e. barter) or payment. Hence, as gift certificates, rebates, conveying money, cash surrogates and stored value vehicles represent goods or services and/or payment, individually or in combination each does not represent a financial transaction as a whole.

Claims 19 and 20 recite "including the step of encrypting some of the data with private key to private key encryption". To one of ordinary skill, it is not clear the cryptographic method that the Applicant is referring to.

Claim Rejections - 35 USC § 102

8. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

9. Claims 1-7, 15, 16, and 18-20 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Gabber et al., U.S. Patent No. 5,961,593.

As per claims 1-7, 15, 16, and 18-20, Gabber et al. teach a method for using a computer system to implement a financial transaction comprising:

- providing a first web site having identifier data (figure 3)
- encrypting the identifier data (column 8, lines 17-34; column/line 8/63-9/49)
- using a URL to log on to a second website using the encrypted identifier data (abstract; figures 1 and 3-5; column 5, lines 5-33; column/line 5/57-6/61; column 10, lines 10-40)
- implementing the financial transaction (e.g. purchase) using the encrypted identifier from the second website (column 6, lines 58-67; column 8, lines 18-34; column/line 12/45-13/14)
- using a browser to communicate payment data over the internet (figures 3-5; column 6, lines 58-67; column 8, lines 18-34; column/line 12/45-13/14)
- reconciling a payment for the purchase invisibly to the purchaser by using the payment data communicated by the browser to implement the financial transaction (column 6, lines 58-67; column 8, lines 18-34; column/line 12/45-13/14)
- triggering (using a proxy server), over the internet, encrypted real-time payment data from a non-customer computer to a vendor computer without customer intervention (column 6, lines 58-67; column 8, lines 18-34; column/line 12/45-13/14)

- facilitating the transaction using a broker, agent or middleman (column 6, lines 58-67; column 8, lines 18-34; column/line 12/45-13/14)
- executing a card account/bank account to carry out the financial transaction (column 6, lines 58-67; column 8, lines 18-34; column/line 12/45-13/14)
- encrypting the data using a private key (only known by the proxy server) (column 9, lines 10-49)
- attaching data identifying the financial transaction to an electronic communication transmitted to enable carrying out the financial transaction (column 14, lines 26-47)

Claim Rejections - 35 USC § 103

10. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 8-14 and 21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gabber et al., U.S. Patent No. 5,961,593 in view of Small, U.S. Patent No. 5,513,117.

As per claims 8-14 and 21, Gabber et al. disclose a user obtaining goods and services over the internet using a debit or credit card (column/line 12/45-

13/14). Gabber et al. does not disclose attaching data identifying a gift (e.g. gift certificate, etc.) to an internet greeting card. Small teaches a user purchasing, using a credit or debit card, an internet greeting card and selecting a gift to go along with the card, and sending the card to the user over the internet (abstract; figures 6 and 17; column 7, lines 15-40 and 58-62; column 10, lines 5-10). Small also teaches implementing a redemption over the internet by a recipient of the card using the gift. For example, the recipient can access downloadable software using a computer (column 7, lines 23-25). Further, the process of reconciling the value of the gift for redemption is invisible to the recipient as the recipient is unaware of the back-end processing performed by the merchant or service provider that enables, for example, the downloading of software (column 7, lines 23-25). In addition, Small discloses redeeming a gift off-line or over the phone (column 7, lines 26-29; column 8, lines 43-48; column 9, lines 8-27; column 10, lines 20-30) wherein the reconciling of the value of the gift for redemption is invisible to the recipient as the recipient is unaware of the back-end processing performed by the merchant or service provider such as the process of authenticating the redemption (column 10, lines 25-30). It has been held that it is not 'invention' to broadly provide a mechanical or automatic means to replace manual activity which has accomplished the same result (*In re Venner*, 120 USPQ 192 (CCPA 1958); *In re Rundell*, 9 USPQ 220 (CCPA 1931)) and "if a person of ordinary skill can implement a predictable variation, §103 likely bars its

patentability". Therefore, ignoring the teaching of using the gift to access downloadable software (column 7, lines 23-25), the off-line and phone redemption embodiment of Small is sufficient to render using the internet to redeem a gift obvious to one of ordinary skill.

12. Claims 9-14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gabber et al., U.S. Patent No. 5,961,593.

As per claims 9-14, Gabber et al. provide a method and system to allow a user to securely purchase goods and services over the internet (abstract; figures 1-5; column 6, lines 58-67; column 8, lines 18-34; column/line 12/45-13/14). Gift certificates, coupons, rebates and the like are all goods or services, hence, it would have been obvious to one of ordinary skill to purchase a gift such as a gift certificate using the credit card purchasing method of Gabber et al. (column/line 12/45-13/14).

13. Claim 17 is rejected under 35 U.S.C. 103(a) as being unpatentable over Gabber et al., U.S. Patent No. 5,961,593 in view of Linehan, U.S. Patent No. 6,327,578.

As per claim 17, Gabber et al. teach a method and system for anonymously obtaining goods and services over the internet (abstract; figures 1-5). Gabber et al. also teach maintaining private user data on a user's computer

(column 5, lines 5-28; column/line 5/58-6/17; column 6, lines 36-51). However, Gabber et al. do not specifically recite digital wallets. Linehan teaches a wallet enabled browser for securely maintaining private user data (column 2, lines 17-31; column 14, lines 23-33). Therefore, it would have been obvious to one of ordinary skill to combine the teachings of Gabber et al. and Linehan in order to securely store and communicate transaction data such as credit/debit card data or shipping instructions to allow for more efficient and secure online purchases ('578, column 2, lines 17-31).

Conclusion

14. To avoid abandonment of the application, appellant must exercise one of the following two options:

(1) file a reply under 37 CFR 1.111 (if this Office action is non-final) or a reply under 37 CFR 1.113 (if this Office action is final); or,

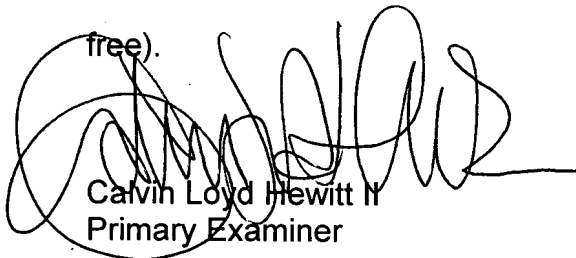
(2) initiate a new appeal by filing a notice of appeal under 37 CFR 41.31 followed by an appeal brief under 37 CFR 41.37. The previously paid notice of appeal fee and appeal brief fee can be applied to the new appeal. If, however, the appeal fees set forth in 37 CFR 41.20 have been increased since they were previously paid, then appellant must pay the difference between the increased fees and the amount previously paid.

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15. Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Calvin Loyd Hewitt II whose telephone number is (571) 272-6709. The Examiner can normally be reached on Monday-Friday from 8:30 AM-5:00 PM.

If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, Andrew Fischer, can be reached at (571) 272-6779.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-

free).

Calvin Loyd Hewitt II
Primary Examiner

September 7, 2007


Andrew Fischer
SPE Art Unit 3621